

Appln No. 09/693,690  
Amdt. Dated May 1, 2006  
Response to Office action of March 3, 2006

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### **REMARKS/ARGUMENTS**

The Applicant thanks the Examiner for the Office Action dated March 3, 2006.

#### **Claim Rejections - 35 USC § 112**

In order to simplify further examination of this case, claims 4, 5, 30 and 31 have been made dependent claims. Claims 6, 7, 32 and 33 have been cancelled.

Claims 1 and 27 have also been clarified so that it is explicitly clear that the form has printed thereon a plurality of tags, with each tag containing coded data indicative of its own location on the form. Basis for this amendment can be found at, for example, page 8, lines 15-16 and page 13, lines 24-25 of the specification.

In response to the Examiner's rejection under 35 USC § 112, 2<sup>nd</sup> paragraph, the claims have been amended to clearly point out which method steps form part of the claimed subject-matter. Further, as recommended by the Examiner, the operation of the sensing device has been placed in a "wherein" clause at the end of claims 1 and 27.

As regards the Examiner's assertion that it is unclear what functions the "sensing device" performs, the Applicant submits that the claims and specification make this abundantly clear. As the Examiner notes, the "sensing device" senses the coded data printed on the form and uses this to generate indicating data regarding the identity of the form and the position of the sensing device. If the Examiner considers it unclear that the "sensing device" not only senses coded data but also generates indicating data, then the Applicant would be pleased to remove the word 'sensing' from the term "sensing device". However, in the Applicant's submission, the term "sensing device" is appropriate because it conveys at least *some* of the functionality of the device. The Applicant is unaware of a more appropriate term (other than the more vague term "device") and would gladly consider any alternative terms proposed by the Examiner.

In view of the Examiner's comment (page 4, lines 3-6 of the most recent Office Action) that the printing step is not considered to be germane to the invention as defined in the claims, this feature has moved to the preamble of independent claims 1 and 27.

#### **Claim Rejections - 35 USC § 103**

The Applicant notes that the Examiner is now satisfied that Dougherty fails to disclose that the computer system receives indicating data from the sensing device regarding its position relative to the form (page 5, final paragraph of the most recent Office Action).

However, the Applicant contests the Examiner's assertion that Henderson in combination with Dougherty would lead the skilled person to arrive at the present invention.

Henderson relies on the use of the well-known x-y digitizer to determine a position of a sensing device. Henderson states, at column 13, lines 45-47 that:

*... the x-y digitizer may be of any suitable type, such as electromagnetic, electrostatic, touch, optical, ultrasonic and the like.*

In other words, Henderson teaches an electronic device for determining a position of a sensing device. It is immaterial that Henderson places a sheet of paper over its x-y digitizer; the thing doing the job of determining the position of the sensing device is the x-y digitizer.

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By contrast, in the present invention the form has printed thereon, a plurality of tags with each tag containing coded data indicative of its own location on the form. By sensing this printed coded data, the sensing device used in the present invention generates indicating data which is received by the computer system. In other words, the indicating data received by the computer system in the present invention originates not from electronic sensors on an x-y digitizer, but from sensed coded data *printed* on a form.

The combination of Henderson and Dougherty would not obviously lead the skilled person to the present invention, without prior knowledge of the present invention. Given the teaching of Henderson, the skilled person might consider modifying Dougherty by placing Dougherty's form on an x-y digitizer – he could then read Dougherty's 'hotspots' and at the same time determine the position of the sensing device using the x-y digitizer.

However, he would not consider modifying Dougherty's coded data so that he could do away with Henderson's x-y digitizer altogether, as required by the present invention. None of the prior art, *a priori*, teaches the skilled person to make this modification of Dougherty. Accordingly, it is submitted that the present invention is not obvious in view of Dougherty combined with Henderson or any other cited document.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicants:

  
KIA SILVERBROOK

  
JACQUELINE ANNE LAPSTUN

  
PAUL LAPSTUN

C/o: Silverbrook Research Pty Ltd  
393 Darling Street  
Balmain NSW 2041, Australia

Email: [kia.silverbrook@silverbrookresearch.com](mailto:kia.silverbrook@silverbrookresearch.com)  
Telephone: +612 9818 6633  
Facsimile: +61 2 9555 7762